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SYNOPSYS, INC.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

SYNOPSYS, INC., a Delaware corporation,

-) Case No. C03-02289 MJJ (EMC)
-)
-) **PLAINTIFF SYNOPSYS, INC.'S REPLY**
-) **BRIEF IN SUPPORT OF MOTION TO**
-) **COMPEL RESPONSES TO SYNOPSYS,**
-) **INC.'S FIRST SET OF**
-) **INTERROGATORIES**
-)
-) Date: May 12, 2004
-) Time: 10:30 a.m.
-) Courtroom: C, 15th Floor
-) Judge: Hon. Edward M. Chen

Plaintiff,

VS.

RICOH COMPANY, LTD., a Japanese corporation

Defendant.

Case No. C03-02289 MJJ (EMC)
Synopsys' Reply Brief ISO Motion to Compel
Responses to Synopsys First Set of Interrogatories

1 I. INTRODUCTION

2 Ricoh raises three arguments in opposition to Synopsys' Motion to Compel Responses to its
 3 First Set of Interrogatories: 1) Synopsys failed to meet and confer; 2) Synopsys' interrogatories are
 4 premature under the Patent Local Rules; and 3) Ricoh's supplemental interrogatory responses render
 5 Synopsys' motion moot. Ricoh is wrong on each count.

6 First, Synopsys did in fact properly meet and confer with Ricoh regarding the issues presented
 7 in this motion. As outlined in Synopsys' motion and in the Declaration of Thomas C. Mavrakakis in
 8 Support of Plaintiff Synopsys, Inc.'s Motion to Compel Responses to Synopsys' First Set of
 9 Interrogatories ("Mavrakakis Decl."), the parties corresponded regarding this issue on numerous
 10 occasions and met and conferred in person on March 24, 2004. Synopsys met its obligations under the
 11 Federal Rules of Civil Procedure and the Local Rules.

12 Second, as shown in its motion, Synopsys' interrogatories are not premature under the local
 13 patent rules. Ricoh's argument relies on a misstatement about its position in this litigation, and should
 14 be rejected.

15 Third, Ricoh's supplemental interrogatory responses do not render Synopsys' motion moot as
 16 those responses are *still* inadequate.

17 Importantly, though *voicing* opposition to Synopsys' motion to compel responses to
 18 Interrogatory Nos. 1-3, Ricoh's *actions* speak louder. Ricoh previously argued that these
 19 interrogatories sought information that was not relevant to any claim or defense. Ricoh fails to argue
 20 this point in opposition to Synopsys' motion, and therefore tacitly admits that these interrogatories
 21 seek relevant information. In addition, while arguing that the interrogatories are premature, in
 22 response to Synopsys' motion, Ricoh in fact supplemented, albeit inadequately, its responses and
 23 provided Synopsys with some information.

24 The Court should compel Ricoh to supplement its inadequate interrogatory responses to
 25 provide fully and completely the requested information.

1 II. **ARGUMENT**

2 A. **Synopsys met and conferred as required under the Local Rules.**

3 Ricoh first argues that Synopsys did not meet and confer as required under the Patent Local
4 Rule 3-5(b). This is not true.

5 As Mr. Mavrakakis stated under penalty of perjury, in his March 31, 2004 declaration,
6 Synopsys “conducted a meet and confer in person with Mr. Brothers, to discuss the parties’ dispute
7 concerning Ricoh’s responses to Synopsys’ First Set of Interrogatories.” Mavrakakis Decl. at ¶7.
8 While Mr. Brothers’ “notes and recollection reflect that the only issue that was discussed with Mr.
9 Mavrakakis on that occasion related to a Rule 12(c) motion made by the defendants in the companion
10 case,” Mr. Mavrakakis has a specific recollection of meeting and conferring with Mr. Brothers
11 regarding the issues presented in this motion. *See* Mavrakakis Decl. at ¶7.

12 In fact, Mr. Brothers’ recollection is nonsensical. As of March 24, 2004, the customer
13 defendants’ motion to dismiss under Rule 12(c) had been fully briefed and the parties were merely
14 awaiting the Court’s hearing on the matter to be held on April 6, 2004. The only issues over which the
15 parties needed to meet and confer were those presented in this motion and in the customer defendants’
16 motion to strike Ricoh’s preliminary infringement contentions, the two issues that Mr. Mavrakakis
17 discussed with Mr. Brothers on March 24. There was no reason for the parties to meet and confer
18 regarding the customer defendants’ Rule 12(c) motion to dismiss.

19 Synopsys met and conferred *in person* as required under the Local Rules and this Court’s
20 Standing Order Re Discovery Disputes.

21 Aside from the fact that Synopsys has complied with the meet and confer requirements for its
22 motion to compel regarding these discovery requests, Patent Local Rule 3-5(b) does not apply to this
23 litigation. Patent Local Rule 3-5(a) provides that:

24 If the defendant does not assert a claim for patent infringement in its
25 answer to the complaint, no later than 10 days after the defendant serves
26 its answers, or 10 days after the Initial Case Management Conference,
27 whichever is later, the party seeking a declaratory judgment must serve
28 upon each opposing party its Preliminary Invalidity Contentions that
 conform to Patent L.R. 3-3....

1 Synopsys must therefore, serve its contention no later than 10 days after the Initial Case Management
 2 Conference, which is currently scheduled for May 4th. Because the Patent Local Rules are already
 3 “triggered” by Patent Local Rule 3-5(a) in this litigation, Patent Local Rule 3-5(b) simply does not
 4 apply. Patent L.R. 3-5(b) (“If filings or actions in a case do not trigger the application of these Patent
 5 Local Rules under the terms set forth herein, the parties shall, as soon as circumstances become
 6 known, meet and confer for the purpose of agreeing on the application of these Patent Local Rules to
 7 the case.”) (emphasis added).

8 Although it does not apply, even if Patent Local Rule 3-5(b) did apply to this litigation the
 9 parties have met and conferred more than once regarding the application of the Patent Local Rules to
 10 this litigation as they were required to do in preparation for the Initial Case Management Conference
 11 and in their preparation of the required Joint Case Management Conference Statement. Specifically,
 12 Synopsys and Ricoh have met and conferred a few times regarding Patent Local Rule 2-1(a)(1), which
 13 provides that the following topic must be discussed when the parties meet and confer pursuant Rule
 14 26(f) of the Fed. R. Civ. P. and addressed in the Case Management Statement required by that Rule:
 15 “Proposed modification of the deadlines provided for in the Patent Local Rules, and the effect of any
 16 such modification on the date and time of the Claim Construction Hearing. . .”¹ Thus, Ricoh’s
 17 argument that the parties have not complied with and that these discovery requests are premature
 18 because of Patent Local Rule 3-5(b) should be rejected out-of-hand.

19 B. **Synopsys’ interrogatories are not premature under the Local Patent Rules.**

20 Ricoh’s argument that Synopsys’ interrogatories are premature relies on a fundamental
 21 misstatement about its position in this litigation. The Court must reject Ricoh’s argument.

22 To the extent that its argument is understandable, Ricoh appears to be arguing that, because it is
 23 a patent owner, Patent Local Rule 2-5 excuses its inadequate responses as seeking claim construction
 24 positions (Patent Local Rule 2-5(a)) or a comparison of the asserted claims to the accused

25
 26 1 Because the Initial Case Management Conference has been re-scheduled a few times by the Court,
 27 the parties have had to prepare for that conference a few times.
 28

1 instrumentality (Patent Local Rules 2-5(b)). However, Ricoh's argument puts the cart before the
 2 horse. Since Ricoh has not asserted a counterclaim of patent infringement in this action, Patent Local
 3 Rule 2-5 by its own terms does not apply.

4 Patent Local Rule 2-5 only applies where there is an applicable "timetable provided in the
 5 Patent Local Rules." Patent L. R. 2-5. Patent Local Rule 2-5 further provides that a party's discovery
 6 obligations under the Federal Rules of Civil Procedure are excused *only* when the Patent Local Rules
 7 conflict with those duties. *See id.* Here, since Ricoh has not filed a counterclaim for patent
 8 infringement (and in fact has used that fact to avoid the Patent Local Rules' obligation to serve
 9 Preliminary Infringement Contentions in this matter), there is no applicable timetable provided under
 10 the Patent Local Rules, which conflicts with the Federal Rules of Civil Procedure. Therefore, Ricoh
 11 cannot rely on Patent Local Rule 2-5(b) to excuse its obligations under the Federal Rules of Civil
 12 Procedure.

13 Putting Ricoh's argument informally, Ricoh's position is a classic example of wanting to have
 14 one's cake and eat it too. Ricoh does not want to file Preliminary Infringement Contentions under
 15 Patent Local Rules 3-1, but wants to impose the timetable under the Patent Local Rules as if it had.
 16 Either Ricoh must file Preliminary Infringement Contentions or respond to Synopsys' interrogatory
 17 responses. Since it has chosen to avoid filing Preliminary Infringement Contentions, it must respond
 18 fully and completely to Synopsys' interrogatories.

19 In fact, Patent Local Rule 2-5 does not excuse responding to discovery requests. It only allows
 20 a patent claimant to delay responding until the day its Preliminary Infringement Contentions are due.
 21 Here, Ricoh is not a patent claimant because it has declined to provide a Preliminary Infringement
 22 Contention in the present action. Patent Local Rule 2-5 was not meant to excuse Ricoh's discovery
 23 obligations but only to delay them where there is an applicable timetable. Consequently, Ricoh's
 24 reliance on that rule for these discovery requests is completely misplaced.

25 Equally misguided is Ricoh's argument that Interrogatories Nos. 1-3 "seek to elicit [Ricoh's]
 26 claim construction positions" under Patent Local Rule 2-5(a). Interrogatories Nos. 1-3 seek
 27 identification of 1) the functions in Synopsys software products that are capable of meeting the
 28

elements of the ‘432 patent claims; 2) evidence supporting Ricoh’s claim that Synopsys software products have those functions and 3) evidence supporting Ricoh’s claim that those products are capable of meeting the elements of the ‘432 patent claims. Ricoh is simply required to provide the identification of functions in the accused software, the evidence supporting that the software has those functions, and any evidence supporting that the software infringes. Because Ricoh’s response to these discovery requests will not require Ricoh to provide or set forth its claim construction position for any of the terms in the ‘432 patent claims, Patent Local Rule 2-5(a) is completely inapplicable and does not provide any basis for delaying its response.

Ricoh’s arguments that responding to these requests improperly require Ricoh to construe the claims and that Patent Local Rule 2-5(a) “permits a party to object to doing so before required in the timetable provided in the Patent Local Rules” are simply wrong. The Patent Local Rules address the timing of Ricoh’s disclosure of its claim construction positions to Synopsys not when it formulates those positions.² See Patent L. R. 4. Patent Local Rule 2-5(a) provides a means for delaying the timing of Ricoh’s disclosure of its claim construction positions only. The requests here do not seek those positions. Consequently, Patent Local Rule 2-5(a) does not apply.

Again, the Court should reject Ricoh's arguments, and grant Synopsys' motion to compel full and complete answers to its interrogatories.

C. Ricoh's supplemental and second supplemental responses to Synopsys' interrogatories are inadequate.

Last, Ricoh argues that its supplemental interrogatory responses render this motion moot. In response to Synopsys' motion, Ricoh has supplemented its interrogatory responses by, in relevant part, incorporating its Preliminary Infringement Contentions served in *Ricoh Co., Ltd. v. Aeroflex, Inc., et al.*

² In fact, Rule 11 of the Federal Rules of Civil Procedure required Ricoh to construe the claims and based on that construction apply them to the facts it had regarding Synopsys software products and determine that it had a factual basis for claiming infringement for at least one claim before threatening and bringing patent infringement lawsuits against Synopsys' customers for use of those software products. *See e.g., View Engineering, Inc. v. Robotic Vision Sys. Inc.*, 208 F.3d 981, 985-986 (Fed. Cir. 2000) (applying Ninth Circuit law).

1 *al.*, Case No. CV 03-04669 MJJ (EMC). However Ricoh's second supplemental interrogatory
 2 responses are inadequate under the Patent Local Rules in and of themselves and insufficient as
 3 responses to the Synopsys' interrogatories.

4 Ricoh's second supplemental responses failed to serve their intended purpose in the *Ricoh Co.,*
 5 *Ltd. v. Aeroflex, Inc.* litigation.³ As such, they are certainly inadequate as interrogatory responses in
 6 the instant litigation. As set forth in Defendants' Motion to Strike Plaintiff's Disclosure of Asserted
 7 Patent Claims and Preliminary Infringement Contentions, the Patent Local Rules require that Ricoh's
 8 Preliminary Infringement Contentions disclose specific information in a specific way. Ricoh failed to
 9 provide this information, however, when it submitted disclosures that ambiguously designated separate
 10 infringement contentions for multiple companies, in violation of Patent Local Rules' requirement that
 11 Ricoh show "[e]ach claim of each patent in suit that is allegedly infringed by *each opposing party.*"
 12 Patent L. R. 3-1(a) (emphasis added). Ricoh's contentions also failed to comply with the Patent Local
 13 Rules when Ricoh declined to explicitly identify which Synopsys products were being accused, in
 14 violation of the requirement that Ricoh identify each Accused Instrumentality. See Patent L. R. 3-1(b).
 15 Ricoh's contentions were similarly deficient when they failed to state how each product allegedly
 16 meets each element in the asserted claims, in violation of the Patent Local Rules' requirement that
 17 Ricoh identify where each asserted claim is found within each Accused Instrumentality. See Patent L.
 18 R. 3-1(c). Synopsys provides the Court with a chart further illustrating the inadequacies of Ricoh's
 19 Preliminary Infringement Contentions. See Attachment 1.

20 In view of these inadequacies, Ricoh's contentions did not provide the required information in
 21 Ricoh's case against Synopsys' customers. Even more so here, these contentions fail to respond to
 22 Synopsys' discovery. Ricoh's rote incorporation by reference to those contentions, therefore, cannot
 23 serve as responses to Synopsys' interrogatories in the instant litigation. See *Scaife v. Boenne*, 191
 24 F.R.D. 590, 594 (N.D. Ind. 2000). (An answer to an interrogatory "should be complete in itself and
 25

26 ³ Plaintiff's Disclosure of Asserted Patent Claims and Preliminary Infringement Contentions, on
 27 which Ricoh relies in its supplemental responses, is currently the subject of a Motion to Strike. This
 matter is scheduled for a hearing before The Honorable Martin J. Jenkins on May 4, 2004.

1 should not refer to the pleadings, or to depositions or other documents, or to other interrogatories, at
 2 least where such references make it impossible to determine whether an adequate answer has been
 3 given without an elaborate comparison of answers.”) (citations omitted).

4 Notwithstanding these deficiencies, Ricoh’s Preliminary Infringement Contentions fail to
 5 completely address the very information requested in Synopsys’ interrogatories. Ricoh’s supplemental
 6 interrogatory responses only provide information related to claims 13-17 of the ‘432 patent. Since
 7 Synopsys’ declaratory judgment complaint is not limited to these claims, Ricoh’s supplementary
 8 interrogatory responses remain incomplete with respect to claims 1-12 and 18-20.

9 Moreover, these second supplemental responses identify neither (1) the functions of Design
 10 Compiler software that is capable of performing that Ricoh claims meet the elements of the ‘432 patent
 11 nor (2) the evidence supporting Ricoh’s claims that Synopsys’ Design Compiler software is capable of
 12 performing the Design Compiler software functions identified and Ricoh’s claims that Synopsys’
 13 Design Compiler software meets the elements of the ‘432 patent claims. Rather than address these
 14 requests, Ricoh merely references its contentions in the customer suit that mimic the claim language
 15 and certainly fails to link the claim language to the specific functions of the Synopsys’ Design
 16 Compiler software. In fact, Ricoh’s contentions fail to explicitly identify particular functions of
 17 Synopsys’ Design Compiler software at all. The second supplemental responses fail to map or link
 18 any functions in Design Compiler with any claim language.

19 In short, Ricoh is seeking to avoid its discovery obligations. Having provided inadequate
 20 disclosures under the Patent Local Rules for the related litigation, Ricoh is now attempting to
 21 circumvent the discovery process in the instant case by referencing those same inadequate disclosures
 22 in response to Synopsys’ interrogatories. The Court should order Ricoh to (1) provide the information
 23 requested by these interrogatories or (2) confirm that it has no other responsive information and is not
 24 withholding any such information at this time.

1 III. CONCLUSION

2 For all of reasons provided above in and its moving papers, Synopsys' motion to compel
3 further responses to its First Set of Interrogatories, specifically Interrogatories Nos. 1-3, should be
4 granted.

5 Dated: April 21, 2004

Respectfully submitted,

6 HOWREY SIMON ARNOLD & WHITE, LLP

7

8 By: /s/Thomas C. Mavrakakis

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

SYNOPSYS, INC.,
Plaintiff,
vs.
RICOH COMPANY, LTD.,
Defendant.

) Case No. C03-02289 MJJ (EMC)
)
) **MANUAL FILING NOTIFICATION**
) **RE ATTACHMENT 1 TO PLAINTIFF**
) **SYNOPSYS, INC.'S REPLY BRIEF IN**
) **SUPPORT OF MOTION TO COMPEL**
) **RESPONSES TO SYNOPSYS, INC.'S FIRST**
) **SET OF INTERROGATORIES**
)
)

MANUAL FILING NOTIFICATION

Regarding: Attachment 1 to Plaintiff Synopsys, Inc.'s Reply Brief in Support of Motion to Compel Responses to Synopsys, Inc.'s First Set of Interrogatories

This filing is in paper or physical form only, and is being maintained in the case file in the Clerk's office.

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Other (descriptive)

April 21, 2004

Dated: April 21, 2004

Respectfully submitted,

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By: /s/ Thomas C. Mavrakakis

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

18 I am employed in the County of San Mateo, State of California. I am over the age of 18 and
19 not a party to the within action. My business address is 301 Ravenswood Avenue, Menlo Park,
20 California 94025.

On April 21, 2004, I served on the interested parties in said action the within:

22
23 MANUAL FILING NOTIFICATION – ATTACHMENT 1 TO PLAINTIFF SYNOPSYS,
INC.’S REPLY BRIEF IN SUPPORT OF MOTION TO COMPEL RESPONSES TO SYNOPSYS,
INC.’S FIRST SET OF INTERROGATORIES

25 by placing true copies thereof in a sealed envelope(s) addressed as stated below and causing such
26 envelope(s) to be deposited in the U.S. Mail at Menlo Park, California.

27

28

1 Edward A. Meilman
 2 Dickstein Shapiro Morin & Oshinsky, LLP
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- 7
- 8 (MAIL) I am readily familiar with this firm's practice of collection and processing
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- 10 (FACSIMILE) I caused the foregoing document to be served by facsimile transmission to each
 11 interested party at the facsimile machine telephone number shown as stated above.

12 I declare under penalty of perjury that I am employed in the office of a member of the bar of
 13 this Court at whose direction the service was made and that the foregoing is true and correct.

14 Executed on April 21, 2004, at Menlo Park, California.

15 Susan J. Crane
 16 (Type or print name)

17 /s/ Susan J. Crane
 18 (Signature)